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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,325	08/21/2003	James J. Fitzgibbon	79077	7572

22242 7590 02/27/2006

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EXAMINER

VO, NGUYEN THANH

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,325

Applicant(s)

FITZGIBBON ET AL.

Examiner

Nguyen T. Vo

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-17 is/are allowed.
- 6) ☒ Claim(s) 18-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 18-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 of copending Application No. 10/645,318. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are related to a transmit-only apparatus having a plurality of discrete mechanically resonant devices which correspond to a plurality of discrete user assertable inputs.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18, 20-21, 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasai (JP404046494 A, cited by examiner).

As to claim 18, Sasai discloses a method of facilitating selection of a transmission frequency for a transmit-only apparatus (i.e., the remote control transmitter in figure 1) comprising detecting assertion of a particular one of a plurality of discrete user assertable inputs (see the key pad 8 in figure 1); identifying a particular mechanically resonant device of a plurality of discrete mechanically resonant devices as corresponds to the particular one of the plurality of discrete user assertable inputs (see plural discrete resonant devices 4, 5, 6 in figure 1); transmitting a message comprising bearer content that corresponds to the particular one of the plurality of discrete user assertable inputs using the particular mechanically resonant device (see the transmitting device 2). See also the English translated Abstract.

As to claim 20, the key pad 8 in figure 1 of Sasai reads on “one of a plurality of push buttons” as claimed.

As to claim 21, Sasai discloses three discrete mechanically resonant devices as claimed (see mechanically resonant devices 4, 5 and 6 in figure 1).

As to claims 23 and 25, Sasai discloses discrete crystal resonators as claimed (see crystal resonators 4, 5 and 6 in figure 1).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasai in view of Rhee (3,576,482, cited by examiner).

As to claim 19, Sasai does disclose a key pad 8 for generating user inputs, but fails to expressly disclose three discrete user assertable inputs as claimed. Rhee discloses a transmit-only apparatus having three discrete user assertable inputs (see column 7 lines 51-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Rhee to Sasai, in order to provide more convenience to the user because he can control various operation of the remote receivers.

8. Claims 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasai.

As to claims 22 and 24, Sasai does disclose a plurality of discrete mechanically resonant devices 4, 5 and 6 in figure 1. Sasai, however, fails to expressly disclose that the resonant devices comprise either surface acoustic wave devices as in claim 22, or ceramic resonators as in claim 24. The examiner, however, takes Official Notice that the above surface acoustic wave devices and ceramic resonators are known in the art. In addition, those skilled in the art would have appreciated that the above conventional surface acoustic wave devices and ceramic resonators can be used in Sasai without changing the scope and spirit of Sasai's invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional surface acoustic wave devices and ceramic resonators in Sasai, in order to improve the flexibility in circuit design because different resonant devices could be employed in the remote control transmitter.

Allowable Subject Matter

9. Claims 1-17 are allowed.

As to independent claims 1 and 14, the prior art of record fail to disclose or render obvious a combination of a memory and a controller as specified in the claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Isaacman (4,794,622); Alkire (6,356,082); Podowski (4,021,756); Schroder (3,869,671) disclose transmit-only apparatus having resonant device.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen T. Vo whose telephone number is (571) 272-7901. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571)272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen Vo


2-19-2006

NGUYEN T. VO
PRIMARY EXAMINER